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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,841	08/23/2001	Dennis Thomas Gilham	5058	5479
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10 POST OFFICE ROAD - SUITE 110				
SILVER SPRING, MD 20910				
			EXAMINER	
			SHERR, CRISTINA O	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/934,841

Applicant(s)

GILHAM, DENNIS THOMAS

Examiner

Cristina O Sherr

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If the period for reply specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date 01/07/03.
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

1. This communication is responsive to the application filed 23 August 2001. Claims 1-10 have been canceled by preliminary amendment filed 23 August 2001. Claims 11-13 are pending in this case. This case is a continuation of application 09/031744, filed 27 February 1998.

#### ***Information Disclosure Statement***

2. The information disclosure statement filed January 3, 2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. With respect to the patents listed on the information disclosure statement, examiner has reviewed and considered the submission.

#### ***Specification***

3. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

#### ***Double Patenting***

4. Claim 11 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,308,165 B1.

5. Regarding claim 11 –

Although the conflicting claims are not identical, they are not patentably distinct from each other. Claim 1 of U.S. Patent No. 6,308,165 B1 recites:

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- a method of generating a postal indicia for a series of mail items
- determining a period of time
- storing a postage value relating to postage charges dispensed in said period of time
- providing postage data including said postage value
- generating a modified key relating specifically to a mail item by utilizing the secret key and postage data, above
- generating an authentication code by utilizing said modified key and said postage data
- printing said postage data and said authentication code as a postal indicium on said mail item

6. Claim 1 of U.S. Patent No. 6,308,165 B1 differs since it further recites additional claim limitation generating a second modified key and second authentication code based on the first key and authentication for use in a second piece of mail. However, it would have been obvious to a person of ordinary skill in the art to modify claim 1 of U.S. Patent No. 6,308,165 B1 by removing limitations directed to the second mail piece. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

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7. Claims 12 and 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S.

Patent No. 6,308,165 B1 in view of Bird (US

7. Regarding claim 12 –

Although the conflicting claims are not identical, they are not patentably distinct from each other. Claim 2 of U.S. Patent No. 6,308,165 B1 recites:

- a postage meter apparatus for printing postal indicia on a plurality of mail items, said postal indicia including postage data and an authentication code

- clock means operative to determine a period of time in which postal indicia are to be printed on a plurality of mail items;

- a register for storing a postage value relating to postage charges dispensed in said period of time;

- memory means for storing a secret key;

electronic control means

- input means operable to input item data relating to a mail item to said electronic control means, wherein said electronic control means is configured to generate a modified key relating specifically to said mail item by utilizing said secret key and postage data including said item data and said postage value, and generate an authentication code by utilizing said modified key and said postage data

8. Claim 2 of U.S. Patent No. 6,308,165 B1 differs since it further recites additional claim limitation generating a second modified key and second authentication code based on the first key and authentication for use in a second piece of mail. However, it

would have been obvious to a person of ordinary skill in the art to modify claim 2 of U.S. Patent No. 6,308,165 B1 by removing limitations directed to the second mail piece. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969).

Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

9. Regarding claim 13 -

10. Claim 2 of U.S. Patent No. 6,308,165 B1 differs since it fails to recite a register for storing value of credit and wherein said postage data includes said value of credit. Bird teaches a register with keeps track of customer credit. (e.g. Col 1 ln 40 – col 4 ln 55).

11. It would be obvious to a person of ordinary skill in the art to combine the teachings of U.S. Patent No. 6,308,165 B1 and Bird in order that only mail which for which there are sufficient funds receives postal indicia.

12. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

**Conclusion**

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina O Sherr whose telephone number is 703-305-0625. The examiner can normally be reached on Monday through Friday 8:30 to 5:00.


14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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